

REMARKS

No claims have been added or cancelled. Thus, claims 1-4, 6-11 and 13-21 are currently pending. No new matter has been introduced.

I. Rejection of Claims 1, 8 and 15 under 35 USC 112, first paragraph

The Examiner rejected claims 1, 8 and 15 under 35 USC 112, first paragraph as failing to comply with the written description requirement. The Examiner asserted that the limitation "while there is available memory for storing at least one additional record" was not adequately described in the specification to show that the applicant had possession of the claimed invention. This limitation is inherent in the specification as originally filed. For example, referring to the published application for convenience, paragraph [0034] states: "In block 414, the electronic records management, classification and protection system 212 deletes the record and the associated property field from the remote computer 102. After block 414, the electronic records management, classification and protection system 212 returns to block 302." Unlike prior art cited by the Examiner in earlier office actions, there is no requirement that memory be full to delete the record. The limitation "automatically instruct the processor to delete one or more of the records from the memory while there is available memory for storing at least one additional record" found in claim 1, 8 and 15 is not met by a system or method that only deletes records when memory becomes full.

II. Rejection of Claims 1-2, 7-9, 13-16 and 19-21 under 35 USC 102(b)

The Examiner has rejected claims 1-2, 7-9, 13-16 and 19-21 under 35 USC 102(b) as anticipated by US Patent Publication No. 2004/0117315A1 to Cornuejois ("Cornuejois"). It is respectfully submitted that claims 1-2, 7-9, 13-16 and 19-21 are not anticipated by Cornuejois because Cornuejois, does not teach all the limitations of Claims 1-2, 7-9, 13-16 and 19-21, in view of the limitations of claims 1, 8 and 15.

For example, without limitation, Cornuejois does not teach classifying the one or more records at the remote computer. Additionally, Cornuejois does not teach automatically deleting one or more records while there is available memory for storing at least one additional record."

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference." *MPEP* § 2131 (citing *Verdegual Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)).

The Examiner relies upon the statement that "when no transaction is detected, a site page trace is stored in a permanent memory and automatically deleted as a function of the permanent memory space which is available and or allocated to the implementation of the invention," for establishing that Cornuejois teaches the limitation of "automatically deleting one or more records while there is available memory for storing at least one additional record." The language cited by the Examiner can easily be interpreted as indicating that the record is only deleted when the memory space is full, similar to assertions made in earlier office actions that "when the remote data is filled with one or more file, the program monitor will delete one or more record from local (memory)." Such asserted deletion, if it in fact occurs, does not meet the limitation of deleting one or more records while there is available memory for storing at least one additional record as recited in claims 1, 8 and 15 as amended.

Therefore, it is respectfully requested that the rejection be withdrawn.

III. Rejection of Claims 1-4, 6-11, 13-21 under 35 USC 103(a)

The Examiner has rejected claims 1-4, 6-11, 13-21 under 35 USC 103(a) as obvious over US Patent No. 6,122,663 to Lin et al. ("Lin") in view of US Pub. No. 200400832270 ("Heckerman") (collectively the "References"). It is respectfully submitted that claims 1-4, 6-11, 13-21 are not obvious over the References because the combination of the References as suggested by the Examiner does not teach all the

limitations of Claims 1-4, 6-11, 13-21 in view of the limitations of claims 1, 8 and 15 from one of which each of the rejected claims depend.

In order to establish a prima facie case of obviousness "all of the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981 (C.C.P.A. 1974). "If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is not obvious." MPEP 2143.03 (citing In re Fine, 837 F.2d 1382, 1385 (C.C.P.A. 1970)).

The Examiner states that Lin inherently teaches deleting the records from memory when the memory is full and explicitly teaches all of the other limitations of the claims, except classifying a record, which is taught by Heckerman. The Examiner indicated that Lin does not classify the records at the remote computer, as is recited in claims 1, 8 and 15 as amended. Additionally, repeatedly in paragraph 4, the Examiner indicated that he asserts that "when the remote data is filled with one or more file, the program monitor will delete one or more record from local (memory)." Such asserted deletion, if it in fact occurs, does not meet the limitation of deleting one or more records while there is available memory for storing at least one additional record as recited in claims 1, 8 and 15 as amended. The combination of Lin and Heckerman are not believed to teach or suggest all of the limitations of the independent claims from which the rejected claims depend as neither Lin nor Heckerman teach or suggest the limitation of deleting one or more records while there is available memory for storing at least one additional record as recited in claims 1, 8 and 15.

Therefore, it is respectfully requested that the rejection be withdrawn.

CONCLUSION

For at least all of the foregoing reasons, it is respectfully submitted that claims 1-4, 6-11 and 13-21 are allowable. Favorable reconsideration and allowance of this Application is therefore respectfully requested. Applicants hereby request pursuant to 37 CFR 1.136(a) a three month extension of time to and including March 18, 2009, rendering this response timely upon the granting of the extension of time. The Director is

Appl. No. 10/748,080
Amdt. Dated March 18, 2009
Reply to Office Action of Sep. 18, 2008
Page 9 of 9

hereby authorized to charge the fee for a three month extension of time in the amount of \$1100.00, and any other fees which may be required, or credit any overpayment, to Deposit Account Number 09-0007. If applicants have inadvertently overlooked the need to petition for any additional extension of time or to pay an additional fee, Applicants conditionally petition therefore, and authorize any fee deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

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